

REMARKS

Claims 1-18 are pending in the application.

Claims 1-18 have been rejected.

Claims 1, 10 and 16-18 have been amended.

Prior to responding to the rejections in the Office Action, Applicants note that certain of the claim limitations have been amended simply to improve clarity or to address certain informalities. In clarifying the claim language or correcting informalities, these amendments are not intended to limit the scope of the claims, unless the claim language is explicitly referred to in the following arguments to distinguish over one or more of the cited references.

Rejection of Claims under 35 U.S.C. § 112

Claims 1, 10 and 16-18 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. Applicants respectfully traverse this rejection.

In response to the Office Action, and in the interests of economy, Applicant has amended the above claims to address the Examiner's 35 U.S.C. §112, para. 2 concerns. The Final Office Action raises for the first time the Examiner's suggestion that the phrase "eliminating from the plurality of entries one or more entries that provide for one or more impossible actions" lacks clarity. Applicant has provided an amendment to each of the independent claims that provides additional clarity to the phrase of concern. Applicant submits that the amended language finds support within the specification, for example at page 13, and therefore adds no new matter to the Application.

For the above reasons, Applicant submits that Claims 1, 10 and 16-18, as amended, are allowable. Therefore, Applicant respectfully requests Examiner's reconsideration and withdrawal of the final rejection under 35 U.S.C. § 112 para. 2, especially in light of this rejection being raised for the first time in the Final Office Action.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,625,591 issued to Vahalia *et al.* ("Vahalia") in view of U.S. Patent 6,279,112 issued to O'Toole, Jr. *et al.* ("O'Toole"), and for additional cited art for certain claims. Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Each of the independent Claims 1, 10 and 16-18, as amended, include limitations substantially of the following form:

determining whether one or more entries of the plurality of entries provides for an impossible action, wherein

each entry of the plurality of entries comprises an associated condition, and

said determining comprises

selecting a first entry of the plurality of entries, and
for each entry of the plurality of entries except the first
entry,

determining whether the condition associated with
the entry can be satisfied if a first condition
associated with the first entry is satisfied, and
identifying the entry as providing for an impossible
action if the condition associated with the entry
cannot be satisfied; and

eliminating from the plurality of entries the one or more entries, if any,
that provide for an impossible action, wherein

the removing of non-terminating entries and the eliminating of the
one or more entries that provide for an impossible action, if any,
produce a single list preserving tracing of the entries in the single
list to the plurality of entries.

See, e.g., Claim 1 (as amended). Applicant respectfully submits that neither of Vahalia
nor O'Toole, alone or in combination, discloses these claim limitations.

As discussed in Applicant's response to the previous Office Action, neither
Vahalia nor O'Toole present any disclosure of impossible actions, either explicitly or
implicitly, and therefore cannot disclose the "eliminating" limitation nor the amended
"determining" limitation. *See Response to Office Action, pp.9-12 (October 18, 2005).*
The cited sections of the references make no mention of impossible actions as that phrase
is defined in the present application and claimed in the independent claims, both as
originally presented and as hereby amended. The Final Office Action provides no
response to the substance of the discussion presented in the October 18 Response.
Instead, the Final Office Action states that "it is the position of the Examiner that the
description of impossible action in the specification is insufficient and confusing." Final
Office Action, p.16 (referring to the 35 U.S.C. § 112 rejections). As stated above in the
section related to 35 U.S.C. § 112, the independent claims have been amended to provide

language clarifying an “impossible action.” These amendments find support in the Application at least at p.10, ll.24-27, p.11, ll.22-27, and p.13, ll.11-15. Applicant respectfully submits that this amended language resolves any confusion presented by the phrase “impossible action,” and that the claims are therefore in condition for allowance.

Thus, Vahalia and O’Toole, failing to even recognize the possibility of an impossible action, cannot be said to show, teach or suggest the elimination of impossible actions as claimed. Nor can the references be said to show, teach or suggest determining whether an entry provides for an impossible action, as presented in the claims as amended. Furthermore, given the foregoing arguments and those presented in the October 18 Response, neither Vahalia nor O’Toole can be said to show, teach or suggest the production of “a single list preserving tracing of the entries in the single list to the plurality of entries.”

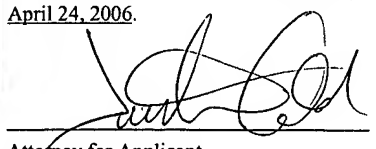
The independent claims also contain a limitation directed toward “removing non-terminating entries from the plurality of entries....” In response to Applicant’s October 18 Response that indicates neither Vahalia nor O’Toole disclose such a limitation, the Final Office Action refers to the same portion of text previously cited (Vahalia 6:10-17). Applicant has carefully studied the above cited disclosure and can find no reference, for example, to a non-terminating entry nor to removing a non-terminating entry. Applicant requests that the Examiner more specifically point out portions of Vahalia 6:10-17 upon which the Examiner believes elements of the independent claims read. *See* MPEP §§706-707; 37 C.F.R. 1.106(b). The only text in the cited disclosure that refers to removing is “[a] hash list entry is zero as a result of removing a pointer from the hash list.” Vahalia 6:16-17. But there is no correlation made in the reference, either explicitly or implicitly,

nor in either office action, between the pointer removed from the hash list and a non-terminating entry of the claim. The office actions make no claim that O'Toole provides this missing disclosure.

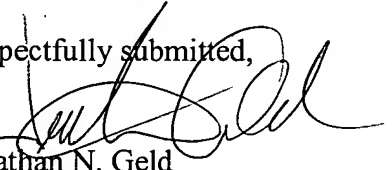
For at least the above reasons, and reasons expressed in the October 18 Response to Office Action, Applicant respectfully submits that the Final Office Action has failed to establish or support a *prima facie* case of obviousness. In addition to the claim elements not being taught or suggested by the cited references, the Office Actions have not shown that there is some understandable suggestion or motivation to combine Vahalia and O'Toole, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicant refers the Examiner to the prior Response to Office Action for the discussion related to lack of suggestion or motivation to combine the references.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

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|  | <u>4/24/2006</u> |
| Attorney for Applicant | Date of Signature |

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